1626

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Boyd et al.	
Serial No.:	10/542,169 **Case No.:** 21242P	Art Unit 1626
Filed:	July 13, 2005	**Auth. Off.:** G. Shameem
For:	Ophthalmic Compositions for Treating Ocular Hypertension	

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TOREQUIREMENT FOR RESTRICTION

Sir:

This is a response to the restriction requirement of November 19, 2007 for which a response is required December 19, 2007. Claims 1-24 are currently pending in the application and are subject to the following restriction under 35 U.S.C. 121:

Group I: Claims 1-10, drawn to compounds of formula I classified in classes 544, 546, 548 and numerous subclasses.

Group II: Claim 11, drawn to compounds classified in class 544, 546, 548 and numerous subclasses.

Group III: Claims 12-15, 17-19 and 21-22, drawn to a method of treating a disease classified in class 514 and several subclasses.

Group IV: Claim 16 drawn to method of use of a compound classified in class 514 and several subclasses.

Group V: Claim 20 drawn to method of use of a compound classified in class 514 and several subclasses.

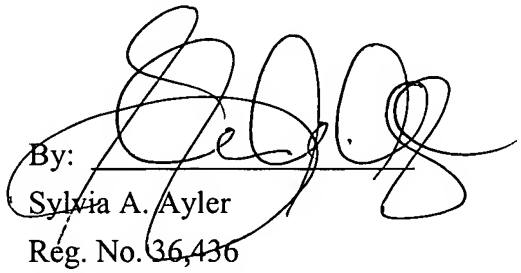
Group VI: Claims 23 and 24 drawn to a process for making a compound classified in class 548 and several subclasses.

Applicants elect Group I, Claims 1-10, drawn to compounds of formula I classified in classes 544, 546, 548 and numerous subclasses with traverse. Applicants further elect the species of Example 41. The Examiner asserts that the restriction is proper because the inventions listed in Groups I to VI do not relate to a single general inventive concept under PCT Rule 13.1 in that they lack the same or corresponding technical features. Applicants respectfully submit that the Examiner fails to justify the restriction requirement as the present invention of Groups I-VI are related. Even though only one invention may be claimed in a single application, a reasonable number of species of the invention can be claimed if there is an allowable generic claim in the application, which is the case of the present application. Accordingly, there is no additional burden on the part of the Examiner to conduct the prior art search for examination of the present application in total. Moreover, a more careful review of claim 11 will reveal that **all** of the compounds claimed therein fall within the scope of compound claim 1. Thus, Groups I and II necessarily share a single general inventive concept and should therefore be rejoined. Claims 1-22 read on the elected species.

The Applicants respectfully submit that the instant application complies with the requirement for unity of invention. As noted in the International Preliminary Examination Report, the International Preliminary Examination Authority did not find a lack of unity of invention. The Examiner is directed to PCT Article 27(1), which states "No national law shall require compliance with requirements relating to the form or contents of the international application **different from or additional** to those which are provided for in this Treaty and the Regulations" (Emphasis added). It is respectfully submitted that the standards for unity of invention for the instant application during the national phase must not be "different from or additional to" those utilized by the International Search Authority (ISA) and International Preliminary Examination Authority (IPEA) during the international phase. Thus, it is respectfully submitted that unity of invention is not lacking, a result previously found by the ISA and IPEA and for this reason the restriction should be withdrawn.

Applicants further request that the Examiner apply procedures for the rejoinder of withdrawn method claims consistent with MPEP 821.04 (e.g. the Official Gazzette Notice (1184 O.G. 86) of March 26, 1996, and the "Training Materials for Treatment of Product and Process Claims in Light of In re Brouwer and In re Ochiai and 35 U.S.C. 103 (b)"). Applicants note that the method claims already include all the limitations of the main product claim.

Respectfully submitted,



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